

REMARKS

Claims 1 - 21 and 24 - 25 remain in the application.

Applicants are not conceding that the subject matter encompassed by the claims as presented prior to this Amendment is not patentable over the art cited by the Examiner, as claim amendments and cancellations in the present application are directed toward facilitating expeditious prosecution of the application and allowance of the currently-presented claims at an early date. Applicants respectfully reserve the right to pursue claims, including the subject matter encompassed by the claims as presented prior to this Amendment and additional claims, in one or more continuing applications.

I. Rejection under 35 U. S. C. §103(a)

Page 4 of the Office Action states that Claims 1 - 4, 7, 14 - 17, and 24 are rejected under 35 U.S.C. §103(a) as being unpatentable over U. S. Patent Publication 2003/0216955 to Miller et al. (hereinafter, “Miller”) in view of U. S. Patent 6,219,654 to Ruffin. Page 8 of the Office Action states that Claims 5 - 6 and 20 are rejected under 35 U.S.C. §103(a) as being unpatentable over Miller and Ruffin in view of U. S. Patent Publication 2004/0068456 to Korisch. Page 10 of the Office Action states that Claims 8, 10, 13, 18 - 19, and 21 are rejected under 35 U.S.C. §103(a) as being unpatentable over Miller and Ruffin in view of U. S. Patent 7,103,561 to Sarkisian et al. (hereinafter, “Sarkisian”). Page 12 of the Office Action states that Claims 9 and 12 are rejected under 35 U.S.C. §103(a) as being unpatentable over Miller, Ruffin, Sarkisian, in view of Official Notice. Page 13 of the Office Action states that Claims 11 and 25

are rejected under 35 U.S.C. §103(a) as being unpatentable over Miller and Ruffin in view of Official Notice. The rejections are respectfully traversed with regard to Claims 1 - 21 and 24 - 25 as currently presented.

Applicants respectfully submit that these claim as currently presented are not rendered obvious by the cited references or combinations thereof (assuming, *arguendo*, that such combination could be made and that one of skill in the art would be motivated to attempt it).

In particular, the final claim element of Claim 1 recites “generating a list of recommended actions, the list having an entry for each of the selected attributes for which the assigned attribute value falls below a threshold, each of the entries providing at least one suggestion for improving the assigned attribute value and a specification of how much the assessment score would be increased if the assigned attribute value was raised to the threshold” (Claim 1, lines 13 - 17, emphasis added). See, for example, the “impact to score if brought to minimum ...” text in Applicants’ Fig. 9 and the corresponding text on p. 29, line 13 - p. 30, line 2 of Applicants’ specification, where this is discussed.

Applicants respectfully submit that Claim 1 is not obvious over the cited references under 35 U. S. C. §103(a) by virtue of (at least) these underlined recitations. Independent Claims 14 and 24 recite analogous claim language, and those independent claims are therefore deemed patentable over the references as well. Dependent Claims 2 - 13, 15 - 21, and 25 are deemed patentable by virtue of (at least) the patentability of the independent claims from which they

depend. The Examiner is therefore respectfully requested to withdraw the §103 rejections.

Additional differences between the present claims and the cited art will now be discussed.

In numbered paragraph 9, the Office Action states that Miller, relative to Claim 1, discloses “determining a plurality of criteria that are important to a target market, and at least one attribute to be used for measuring each of the criteria”. While Miller does discuss the use of criteria, there is absolutely no description of using any attributes for measuring the criteria. The attributes discussed in Miller are not used to measure criteria. As described in paragraph 37, attributes include “product packaging brand, color, price and shape.” While the terms criteria and attributes are employed in Miller, they are not employed in the manner found in Claim 1. Miller in no way uses the color, price or shape to measure any criteria.

Further, the Office Action states that Miller discloses “conducting an evaluation of an IT [information technology] product”. However, Miller appears to be directed to consumer products, such as toothpaste, and fails to discuss information technology products.

Additionally, the Office Action states that Miller discloses “inspecting a representation of the IT product, with reference to selected ones of the attributes”. Relative to this subject matter, the Office Action cites paragraphs 35, 44 and 58. As discussed above, Miller is not directed to and does not discuss IT products. Miller does describe having “interaction sessions which bring consumers 14 together to react to product concepts in 2D rendering and 3D model form”

(paragraph 44). No discussion of ‘attributes’ is found in paragraph 44. Instead, “consumers 14 provide feedback...and suggest ways to improve preliminary product concepts”. Are the “concepts” recited in paragraph 44 supposed to also be attributes? Are these the same attributes that are employed for measuring each of the criteria? As noted in the above paragraph, Applicants are unable to find in Miller that its ‘attributes’ are used to measure criteria. ‘Attributes,’ according the Miller, are apparently the attributes of the consumer product. In paragraph 58 and Figure 8, the consumer product is a toothbrush and the attributes are its color, shape, grip, etc. Per paragraph 35, information received from clients, consumers and competitors is used for developing strategies with respect to product and packaging design and development. As recited in the passage of Claim 1 discussed in the preceding paragraph, at least one attribute is used to measure each of the criteria. No such use of attributes is found in Miller.

The Office Action goes on to state that Miller does not disclose “generating an assessment score, for the IT product, from the assigned attribute values” nor “a specification of how much the assessment score would be increased if the assigned attribute value was raised to the threshold”. The Office Action goes on to state that “Ruffin teaches weighing and combining scores relating to customer objectives for IT products in order to create a total weighted score,” referring to Column 15, line 58 –Column 16, line 18.

Ruffin is a system and program product for performing cost analysis of an information technology implementation. Ruffin identifies "islands" or partitions, comprising a plurality of elements of an existing IT environment which are grouped together by virtue of one or more

common features among these elements. An island in the context of this description can be viewed as a group of IT resources which have a logical reason for being viewed and analyzed as a single entity. An island is not a product per se, but rather a set of hardware and software components and capabilities and human resources which can be viewed as a single entity.

According to the passage from Ruffin cited above:

“Step 901 illustrates the assignment of scores to the previously defined global IT objective information which is part of the island data input to the CORE tool and which has been generated as a result of the customer profiling step 802. The additional island-specific information generated as part of the profiling step 802 for each defined island (i.e., islands n-x for example) is scored in step 902n-902x. In this instance the global profile scores relate to customer objectives 901 such as cost reduction, Web enablement etc. whereas the scored island-specific metrics 902n-902x relate to characteristics of the particular defined IT boundary such as a scoring for the number of servers, skills associated with the S/390 platform, skill associated with the UNIX platform, experienced availability etc.

In step 903, the scored global objectives 901 are used to weight the scored island-specific IT metrics. The weighing is applied in conjunction with the scoring of the global objectives, so that, for example, with a customer who has cost reduction as his highest ranked global objective metrics such as the number of servers per island and S/390 and UNIX skills could receive a higher weighing factor than less cost-sensitive metrics such as World Wide Web enablement. The weighted island scores can now be used to rank each island.”

In other words, Ruffin ranks each island, which is a set of IT resources, relative to each other. Ruffin is NOT directed to ranking or scoring or analyzing individual products. The term attribute is not used in Ruffin. Ruffin does NOT generate an assessment score for an IT product from assigned attribute values. Ruffin performs cost analysis rankings of sets of IT implementations (islands) to compare to each other. So clearly Ruffin does not teach, suggest or disclose generating an assessment score, for an IT product, from the assigned attribute values, nor

does Ruffin teach, suggest or disclose a specification of how much the assessment score would be increased if the assigned attribute value was raised to the threshold.

Accordingly, Applicants submit that Claim 1 distinguishes over the combination of Miller and Ruffin. Independent Claims 14 and 24 were rejected for similar reasons to Claim 1 over the combination of Miller and Ruffin. Therefore, Applicants respectfully submit that these claim as currently presented are not rendered obvious by the cited references or combinations thereof (assuming, *arguendo*, that such combination could be made and that one of skill in the art would be motivated to attempt it).

The Examiner is therefore respectfully requested to withdraw the §103 rejections.

II. Double-Patenting Rejections

Applicants are submitting herewith a terminal disclaimer to obviate the double patenting rejections.

III. Conclusion

Applicants respectfully request reconsideration of the pending rejected claims, withdrawal of all presently outstanding objections and rejections, and allowance of all remaining claims at an early date.

Respectfully submitted,

/Marcia L. Doubet/

Cust. Nbr. for Correspondence: 43168
Phone: 407-343-7586
Fax: 407-343-7587

Marcia L. Doubet,
Attorney for Applicants
Regis. Nbr. 40,999